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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Administrators of the Tulane Educational Fund

Serial No. 76255445

Raymond G. Areaux of Carver, Darden, Koretzky, Tessier,
Finn, Blossman & Areaux, L.L.C. for The Administrators of
the Tulane Educational Fund.

David H. Stine, Trademark Examining Attorney, Law Office
114 (Margaret Le, Managing Attorney).

Before Simms, Seeherman and Rogers, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

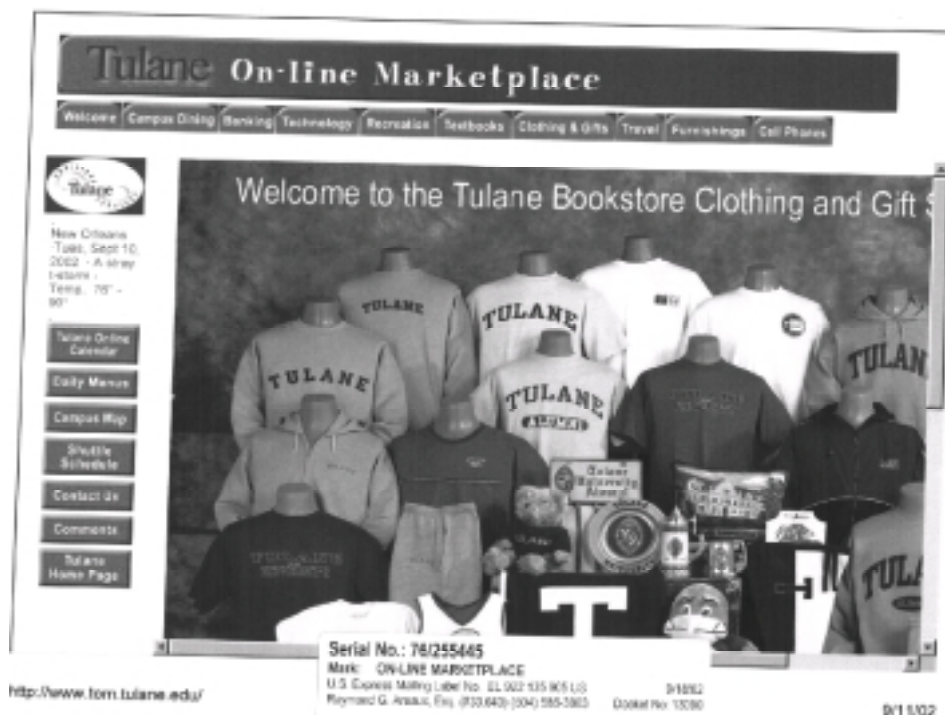
The Administrators of the Tulane Educational Fund
(applicant), a Louisiana non-profit corporation, has
appealed from the final refusal of the Trademark Examining
Attorney to register the asserted mark ON-LINE MARKETPLACE
for the amended description "online retail services
featuring clothing, novelty gift items, books, home

furnishings, computers and computer peripherals.”¹ The Examining Attorney initially refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), on the basis that applicant’s mark is merely descriptive of applicant’s online retail services. Applicant then amended its application to seek registration on the Supplemental Register on September 19, 2002. At that time the Examining Attorney refused registration under Section 23 of the Act, 15 USC §1091, on the ground that applicant’s asserted mark is generic for its online retail services and therefore incapable of identifying applicant’s services and distinguishing them from those of others. Applicant and the Examining Attorney submitted briefs but no oral hearing was held.

¹ The original application, filed May 10, 2001, on the Principal Register, had no declared filing basis, and was later amended to recite that applicant had a bona fide intention to use the mark in commerce as of the filing date. At the same time, in order to amend the application to seek registration on the Supplemental Register, applicant amended the application to assert that it was now using the mark in commerce, and recited dates of use of January 15, 2002.

An earlier description of the services stated: “retail services featuring the retailer’s and others’ goods and services which cater to student, alumni and visitors of a university and other members of the university’s community.” In its appeal brief, p. 11, applicant reiterated an offer it had previously made to the Examining Attorney of a contingent amendment to its identification by adding the following at the end of the current description--“at retail for retail consumers, excluding auction and barter services”--if such an amendment would serve to overcome the genericness refusal. The Examining Attorney, while not objecting to the amendment per se, did not enter it because he determined that it would not overcome the genericness refusal. We agree.

From the specimens of record (portions of which are reproduced below), it is clear that applicant offers "Back-to-School Specials" on various computer products such as notebook computers, desktop computers, printers and software. Applicant's Web site encourages students to "Show your school spirit! Shop for your favorite merchandise online." Merchandise available for purchase at the Web site also includes sheets, rugs, backrests, comforters, hotpots, dinnerware, blenders, utensils, mirrors, hair dryers, towels, irons, bulletin boards, lamps, desks, and various Tulane clothing items including sweatshirts and T-shirts. Also, links to preferred vendors including wireless services, banks, restaurants and bookstores are provided.



public, and that many of the excerpts originated from foreign publications. The Examining Attorney countered in his appeal brief that, in today's electronic age, this evidence is available at the stroke of a key and that this evidence is more likely to be encountered by the actual users or purchasers of applicant's online retail services than would be stories in printed publications.

Applicant's objections are well taken. We have held that stories from such sources as foreign publications or from news wire services are of limited evidentiary value because they are not likely to have had much impact on the relevant public. See *In re Couture*, 60 USPQ2d 1317, 1318 n.2 (TTAB 1999); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1538 n. 2 (TTAB 1998); *In re Organik Technologies, Inc.* 41 USPQ2d 1690, 1691 n. 3 (TTAB 1997); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1931 (TTAB 1996); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1555 n. 6 (TTAB 1987) and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917, 1918 (TTAB 1986). Compare *In re Cell Therapeutics, Inc.*, 67 USPQ2d 1795, 1797 (TTAB 2003)(involving "highly sophisticated medical doctors and researchers" who may have greater access to such sources via the Internet or otherwise). Accordingly, we have given

little weight to references from foreign sources or from proprietary wire services.

We recite below some of only those excerpts from the electronic database which are from U.S. publications:

HEADLINE: ONLINE, TIME IS OF THE ESSENCE;
RETAILERS HEAR TIPS FOR SELLING VIA INTERNET

Another opportunity lies in the increasing number of households using broadband rather than dial-up modems. Broadband users, who now comprise 20 percent of U.S. households, tend to have more money and shop more online. No retailer can afford to ignore eBay and other online marketplaces that will have 25 percent of the online sales by 2005, Johnson said.

Sun-Sentinel (Fort Lauderdale, Fl.), May 8, 2003

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HEADLINE: Blizzard buries retail sales

Bill Angrick, chief executive officer of Washington, D.C.-based Liquidity Services Inc., which manages an online marketplace for retailers to make bulk sales of merchandise, said 45 to 50 retailers posted merchandise on the site...each day from Saturday to Monday.

The Journal News (Westchester County, N.Y.), February 18, 2003

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HEADLINE: Instrument exchange opens online market with ironclad guarantee; Industry Forefront

"The musical instrument industry is massive," said Larry Tedesco, president/CEO, "but until now there has not been a comprehensive online marketplace for musicians and retailers.

InstrumentExchange.com is a full-service auction specializing in musical instruments only and is built by musicians for

musicians. The site's time-saving technology is easier to use and offers the most product information available anywhere. It is clear that musicians prefer to shop at specialty music stores versus general retailer. The same holds true for online auctions. They now have a specialty auction focused only on musical instruments and gear."

Music Trades, February 1, 2003

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HEADLINE: Guitar.com partners with
Gbase.com; Industry Forefront

As an established online retail community, Gbase Gearmail serves as the premier online marketplace for retailers to list their inventory and expand their global reach. The first of its kind for buyers and sellers of vintage and collectible guitars, Gbase receives an astounding four million hits per month.

Music Trades, February 1, 2003

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HEADLINE: ENTERPRISE; EXCHANGE EXPECTS
'DOUBLE-DIGIT' GROWTH

Online marketplace Worldwide Retail Exchange (WWRE) is predicting 'double-digit' growth for its internet trading business this year.

Computing, January 30, 2003

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HEADLINE: Discounters cut into Tower's
music supremacy

A comparison of prices for CDs at traditional retailer Tower, online retailer Amazon.com and "big-box" retailer Best Buy. Amazon also offers an online marketplace for factory-sealed and used CDs at deep discounts [followed by a listing of various products and their prices at various stores and online locations]

The Tennessean, January 12, 2003

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HEADLINE: Visit little-box discounters:
PCs with Web

Another popular bargain site is Half.com, the fixed-price online marketplace that's part of eBay Inc. There are no auctions on this site, but there are bargains on new and used goods.

Last week Half.com featured a "Spider-Man: The Movie" game for PlayStation 2 consoles at \$25.27, 56 percent off the list price.
The Boston Herald, December 16, 2002

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HEADLINE: Market outlook: Hardware/Home improvement industry remains healthy despite uncertain economy

INTERNET ATTENTION TURNS TO ONLINE
MARKETPLACES

Internet-only retailers did not find their pot of gold in the home improvement arena, and it remains to be seen whether traditional retailers will see meaningful results from their online selling efforts either. However, the Internet remains full of promise and opportunity for those companies willing to experiment. Online marketplaces and industry portals are where the next wave of activity will be concentrated, as these technology applications offer real potential to reduce costs and increase efficiencies up and down the channel.

Do-It-Yourself Retailing, November 1, 2001

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HEADLINE: Big Retailers Continue to Dominate Online World

"Bricks-and-Clicks took a tremendous amount of market share from the pure plays," Seth Geiger, vice president of e-commerce and professional services at online marketplace BizRate.com, told a gathering Tuesday at the convention...

One of the biggest winners in the online holiday sweepstakes was Walmart.com, the

once-maligned Web site of the nation's
largest retail chain...

TheStreet.com, January 17, 2001

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HEADLINE: Baseball takes steps to stamp out
fraud

...will be assigned a number and marked with a
hologram meant to be tamper-proof, consumers
eventually will be able to register their
purchases with mlb.com. That not only will
provide a record of the item's ownership but
might create an online marketplace where
buyers can look up specific items and their
owners.

USA Today, January 10, 2001

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HarmonyCentral.com, a leading online
marketplace for musicians, sold its Chicago-
based e-tailing subsidiary, zZounds.com, to
Pinebrook Holdings Inc., a privately held
investment firm focused on technology-
intensive retailing and distribution. Terms
were not disclosed. Pinebrook will operate
zZounds, which sells musical instruments and
recording gear, but two Chicago area retail
stores will be closed.

Chicago Sun-Times, November 28, 2000

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HEADLINE: SHOPPING ONLINE: Bricks go for
clicks; Traditional stores make holiday
online shopping presence felt as buyers turn
to names they know

Traditional retailers have inherent
advantages beyond brand recognition,
analysts say. For one, they don't have to
spend hundreds of thousands of dollars on
branding and can leverage the power of their
offline brands in the online marketplace.

Gap, Nordstrom, Williams-Sonoma and
Target, for instance, could see some of the
biggest increases in online customers
because they have stores.

The Atlanta Journal and Constitution,
November 12, 2000

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HEADLINE: Retailers in Wisconsin's Fox Valley Gear Up for Holiday Sales Season

She attributes the smooth season to the fact the company already had a strong catalogue business customer service base. That just needed a little tweaking to transfer to the online marketplace, she said.

In 1998, LandsEnd.com reported \$61 million in sales. That number grew by 10.5 percent in 1999. "Internet shopping for us has grown every single year," Holmes said. *The Post-Crescent*, November 6, 2000

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HEADLINE: Secondhand stake for Trans World

SecondSpin.com, which began as an online marketplace in 1996, has since added four stores... The company purchases all of its inventory from its customers...

Trans World, based on Corporate Circle in Guilderland, operates retail stores nationwide under the names Record Town, Camelot Music, Saturday Matinee, Strawberries and For Your Entertainment. It also has an online presence at

<http://www.TWEC.com>

The Times Union (Albany, NY), August 16, 2000

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HEADLINE: INDUSTRY FOCUS

Lake Success-based MaterialNet.com, an online marketplace of industrial-metal products has formed a partnership with OnlineMetals.com, an online distributor of metals based in Seattle.

Company officials say the agreement allows them to reach both small and large buyers of steel, aluminum, copper and brass...

Newsday, August 7, 2000

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Cargill Inc., Minnetonka, Sysco Corp., Tyson Foods Inc. and McDonald's Corp. said they will create Electronic Foodservice

Network, an online marketplace for the food-service industry.

Star Tribune, July 26, 2000

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HEADLINE: Business Links On Web Raise
Antitrust Issues

GlobalNetExchange--Sears, Roebuck and Carrefour of France, together with Oracle, plan to create a global online marketplace for the retail industry, inviting other retailers to join. The joint venture will initially focus on the combined \$80 billion in purchases that Sears and Carrefour make from 50,000 suppliers, partners and distributors.

The New York Times, July 7, 2000

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HEADLINE: Recast e-Steel hammers out niche;
Sells technology, not just transactions

...Michael Levin took his molten experience and poured it into a very different mold: e-Steel Corp., an on-line marketplace for buying and selling steel.

Like other business-to-business on-line marketplaces, e-Steel found favor with venture capitalists who saw the profit potential in commissions from on-line transactions.

Crain's New York Business, January 22, 2001

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HEADLINE: Trade exchanges set up shop in
cyberspace

There is no single, neat-and-clean business model for on-line marketplaces. Instead, there are several types of marketplaces, or trade exchanges, that promise to wring time and cost out of their business processes.

Computer-Aided Engineering, January 2001

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HEADLINE: Infopia Announces First
Storefront and Shopping Cart to Use
Artificial Intelligence for Auction and
Marketplace Selling...

"Traditionally, selling on auctions and online marketplaces has been too costly on a product by product basis for merchants with medium- to large-sized inventories..."

Information Superhighways Newsletter, August 1, 2001

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HEADLINE: THE SUBTLE CLEARANCE SALE

ChannelAdvisor helps retailers with every facet of the on-line marketplace, including effective pricing and cross marketing of merchandise to drive sales higher...

"Another shift in the on-line marketplace that appeals to retailers is from variable-price auctions to fixed-price sales," reports Wingo.

Chain Store Age, October 1, 2001

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HEADLINE: Bidding rights: on-line marketplaces claim to offer an effective method for suppliers to put themselves in the shop window as OEMs tender for new business, but can they deliver? Subcontracting.

Engineering, November 1, 2001

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HEADLINE: e-BUSINESS - News in brief

YET2COM, an on-line marketplace for intellectual property, has secured third round funding of \$20 million, led by Bayer AG, Caterpillar and 3i.

E-Business, April 30, 2001

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It is the Examining Attorney's position that the evidence of record (dictionary definitions and Nexis database stories and excerpts) shows that the phrase "on-line marketplace" is in widespread generic use to denote online retail marketplace services such as applicant's

online retail services which comprise an electronic online marketplace of goods and services. More particularly, the Examining Attorney contends that these words are generic for online locations where goods or services may be offered, marketed and acquired by various means (sale, trade or auction), including retail as well as wholesale transactions. The Examining Attorney maintains that applicant's mark is in fact a "genus-naming generic term" (brief, unnumbered page 3) that may be applied to the general category in which applicant's retail services fall. That is, this term has generic significance with respect to a larger category of online services to which applicant's more limited retail services belong.

Moreover, the record clearly indicates that use of such online marketplaces cuts across the full spectrum of commerce, encompassing, *inter alia*, retail, wholesale and business-to-business transactions... It is noted that this standard definition ["a place where a market is set up"] is sufficiently broad to encompass an online location. It is respectfully suggested that these references present a clear, unequivocal indication that the term "online marketplace" is generic with respect to any online place for the marketing or sale of goods/services, including the specific retail services offered by the applicant.

Examining Attorney's appeal brief, unnumbered page 2.

Therefore, according to the Examining Attorney, this term is perceived by the relevant public as a common name for

applicant's online retail services, and not as a mark identifying the source or origin of applicant's services.

Applicant, on the other hand, maintains that the Examining Attorney has not made a strong or substantial showing that the term sought to be registered is generic, based upon clear evidence of generic usage. It is applicant's position that the Examining Attorney's evidence shows that the phrase "online marketplace" has been used in connection with business-to-business, auction and trading services but not in connection with online retail services offered to the general public. Also, references from specialty publications are of little evidentiary value, according to applicant, because those publications are not circulated to and read by the general public. That is to say, according to applicant, the evidence shows usage of this term in connection with services other than applicant's retail services and by users other than the general public. Accordingly, applicant argues that the Examining Attorney has not shown by clear evidence the understanding of the relevant public--ordinary consumers. Finally, applicant asks us to resolve any doubt on the issue of genericness in its favor.

Section 23 of the Act, 15 USC §1091, provides that, "For the purposes of registration on the supplemental

register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services." Of course, if a mark is in fact generic, it is incapable of distinguishing applicant's goods or services from those of others because the term may be used to name the category of similar products or services into which a party's goods or services may fall, as well as those of competitors.

With respect to generic terms, Section 14(3) of the Act, 15 USC §1064(3), provides that "The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used." This language is equally applicable to the determination of genericness prior to registration. That is to say, the statutory test of the primary significance of the mark to the relevant public is also the test for determining whether an applied-for mark is or is not registrable.

In determining whether the primary significance of a term is generic, our primary reviewing court has stated:

...[D]etermining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). The critical issue in genericness cases is, therefore, whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus or category of goods in question. *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979); *Zimmerman V. National Assn. of Realtors, Inc.*, 70 USPQ2d 1425 (TTAB 2004); and *In re Recorded Books, Inc.*, 42 USPQ2d 1275 (TTAB 1997). Evidence of the public's understanding of a particular term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, listings in dictionaries, trade journals,

newspapers, and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, *supra*; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994). Finally, we note that, in the context of this *ex parte* proceeding, it is the burden of the Examining Attorney to prove the genericness of the term sought to be registered by clear evidence. *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, *supra*.

The genus, category or class of services is determined on the basis of the services identified in the application. See, e.g., *Magic Wand, Inc. v. RDB, Inc.*, *supra*. As set forth in this application, the category or class of applicant's services is online retail services featuring a variety of goods. Applicant is an online retailer of various goods.

With respect to the issue of whether the term sought to be registered is understood by the relevant public (the general purchasing public) primarily to refer to that class or category of services, we must look to the evidence of record. While the term "online marketplace" has been used (in a generic sense) to refer to online locations where retailers may list their inventory and conduct bulk sales

to other retailers (and not to the general public), and to identify online locations for the sale of specialty goods (e.g., steel) which may not be sold to the general public, there is also clear evidence that this term has been used to identify online retail locations that sell a variety of merchandise to the general public. This evidence shows that the words "online marketplace" have been used in conjunction with online retailing. Thus, the public would understand this term to have this significance both as a result of the ordinary dictionary meaning of these words, as well as how this term has been used in newspapers and magazines distributed to the general public. In addition, applicant's own use tends to show that these words would be perceived as a location where online shoppers may purchase a variety of merchandise (Tulane On-line Marketplace).

It is, of course, true that there can be multiple generic names for a single product or service. That is, any product or service may have many generic designations. But all of the generic names for the product or service belong in the public domain. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §12:9 (4th ed. 2003). Here, the words "online retailer," "online retail store" or simply "online store" may also be generic designations that competitors may freely use. However, we believe that the Examining Attorney has submitted a strong showing that

applicant's asserted mark "ON-LINE MARKETPLACE" will be understood by the general purchasing public primarily as a generic name for the category or class of services which applicant is rendering--an online marketplace of goods and services.

Decision: The refusal of registration is affirmed.